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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,545	09/27/2001	Tomoaki Kawamura	038750.01	1476

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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,545

Applicant(s)

KAWAMURA ET AL.

Examiner

LUONG T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-13, 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 4-13, 15-18 and newly added claim 19 filed on 9/22/2005 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 4-8, 11-12, 16-17, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al. (US 5,796,428).

Regarding claim 4, Matsumoto et al. discloses an electronic camera comprising an imaging element (image pick up part 103, Figures 1-2, Column 8, Lines 44-50); a display device (liquid crystal panel 305, Figure 3, Column 9, lines 5-15) that is provided on a side of the electronic camera opposite to a side of the electronic camera on which a photographing lens (lens 301, Figure 3, Column 8, Line 63 – Column 9, Line 5) is provided and that displays said formed image; a designating device (liquid crystal panel 401 and pen input device 403, Figure 4, Column 9, Lines 23-30; note that the user can perform editing operation over the picture images; and the pen input 403 is used for writing of comments on picture images, Column 10, Lines 25-35) that designates arbitrary positions on a display screen of said display device; a memory

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(storage unit 109, Figure 1, Column 1-5) that stores an image data file (file list 1301, Column 10, Line 53 – Column 11, Line 6) corresponding to the image formed by the imaging element and a designation data file (a change in the album list causes the album list to be saved in step 1908, Figure 19, Column 11, Line 59 – Column 12, Line 11) corresponding to the designated positions; and the image data file and the designation data file are correlated to each other (note that the album list and the new album list with a change (due to editing) are correlated to each other because they are related to the same picture images, Column 11, Line 59 – Column 12, Line 11).

Regarding claim 5, Matsumoto et al. discloses touch sensor (liquid crystal panel 401, Figure 4, Column 8, Lines 13-16, Column 9, Lines 23-27).

Regarding claim 6, Matsumoto et al. discloses wherein said display device displays indications of positions designated by said designating device on corresponding portions on the display screen of said display device (Matsumoto et al. discloses operations available in the edit mode include scaling, rotation, trimming and moving of picture images, and writing of comments with use of a pen input device 403, Figures 8-9, Column 10, Lines 30-35).

Regarding claim 7, Matsumoto et al. discloses wherein said display device displays on said display screen control operation indications representing predetermined control operations of said camera (icons 503-506, 602-605, Figures 5-6, Column 9, Line 49 – Column 10, Line 35); control device (controller 111, Figure 1, Column 8, Lines 10-20, Column 9, Line 49 – Column 10, Line 35).

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Regarding claim 8, Matsumoto et al. discloses a shutter release button (a shutter is of a two step, Figure 3, Column 9, Lines 2- 8) that can be half pressed (first shutter release 303, Figure 3, Column 9, Lines 2- 8) and fully pressed (second shutter release 304, Figure 3, Column 9, Lines 2- 8) and wherein said display device starts displaying said image of said object that is formed by said imaging element when said shutter release button is half pressed (liquid crystal panel have function of viewfinder (Column 8, Lines 59-62, Column 9, Lines 5-10).

Regarding claim 11, Matsumoto et al. discloses the display device is able to display indications of designated positions to be superposed on said image when said image is being displayed on said display screen (Matsumoto et al. discloses operations available in the edit mode include writing of comments over the picture images displayed on liquid crystal panel 305 with use of a pen input device 403, Figures 8-9, Column 10, Lines 30-35. This indicates that display device is able to display indications of designated positions to be superposed on said image when said image is being displayed on said display screen).

Regarding claim 12, Matsumoto et al. discloses a control device (Column 7, Lines 45-56) that fixes said image that is being formed by said imaging element at a point of time when said shutter release button is fully pressed, and wherein said display device displays said fixed image until said shutter release button is released after said shutter release button is fully pressed (display a picture image being shot, Column 9, Lines 3-11).

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Regarding claim 16, Matsumoto et al. discloses a recording mode (capture mode, Column 9, Line 49 – Column 10, Line 35); reproduction mode (the album list is read out, Column 12, Lines 12-23); control device (controller 111, Figure 1, Column 8, Lines 10-20, Column 9, Line 49 – Column 10, Line 35).

Regarding claim 17, Matsumoto et al. discloses the electronic camera has a designated position display/recording mode which permits display of said indications of said positions designated by said designating device (note that the user can perform editing operation over the picture images; and the pen input 403 is used for writing of comments on picture images, Column 10, Lines 25-35; this indicates that the camera has a designated position display/recording mode) and in which said designation data file of said designated positions is stored in said memory (a change in the album list causes the album list to be saved in step 1908, Figure 19, Column 11, Line 59 – Column 12, Line 11), and a photographing record mode (capture mode, Column 9, Line 49 – Column 10, Line 35) which permits forming an image by said imaging element and permits display of said indications of said positions designated by said designating device and in which said image data file and said designation data file are stored together (note that the album list and the new album list with a change (due to editing) are correlated to each other because they are related to the same picture images, Column 11, Line 59 – Column 12, Line 11); a control device that switches said camera to said designated position display/recording mode when a predetermined position is designated by said designating device (when the user clicks a file icon 504, this causes the image storage/display unit switches to edit mode, Column 9, Line 49 – Column 10, Line 4).

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Regarding claim 19, Matsumoto et al. discloses the image data file and the designation data file are correlated to each other with file names (file lists for album and new album, Column 10, Lines 1-5).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US 5,796,428) in view of Kusumoto et al. (US 5,311,207).

Regarding claim 9, Matsumoto et al. fails to specifically disclose wherein touch sensor extends in a region that is larger than said display screen. However, Kusumoto et al. teaches the color selecting area 7a and the command selecting area 7b (extended region) are outside of drawing area 7c (display screen) of the tablet 7 (Figure 2, Column 3, Lines 10-67, Column 4, Lines 1-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Matsumoto et al. by the teaching of Kusumoto et al. in order to let the image to be separately displayed.

Regarding claim 13, Matsumoto et al. fails to specifically disclose control operation indications representing predetermined control operations of said camera are prepared in region in which touch sensor extends. However, Kusumoto et al. teach the tablet 7 is divided into color

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selecting area 7a, command selecting area 7b (region in which touch sensor extends), and drawing area 7c (Figure 2, Column 3, Lines 52-67, Column 4, Lines 1-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Matsumoto et al. by the teaching of Kusumoto et al. in order to let the image to be separately displayed.

Regarding claim 15, Kusumoto et al. discloses control operation indications are disposed on a region in which touch sensor extends (command selecting area 7b is outside of drawing area 7c, Figure 2, Column 3, Lines 10-67, Column 4, Lines 1-14).

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US 5,796,428) in view of Tanahashi et al. (US 5,589,857).

Regarding claim 10, Matsumoto et al. fails to specifically disclose wherein said indications of said designated positions are displayed in a form of a trail of a designated position when said designated positions are successively designated by said designating device. However, Tanahashi et al. teaches an image which is the same as the trace drawn on the input surface 13 by the pen P is output as a monitor image (Figure 3, Column 2, Lines 11-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Matsumoto et al. by the teaching of Tanahashi et al. in order to detect an input position drawn on an input surface (Column 1, Lines 17-20).

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7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US 5,796,428) in view of Etoh (US 5,729,289).

Regarding claim 18, Matsumoto et al. fails to specifically disclose wherein said control device initially establishes said recording mode when a power supply of said electronic camera is turned on. However, Etoh teaches the system controller 18 set the record mode upon turn-on the power (Column 5, Lines 40-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Matsumoto et al. by the teaching of Etoh in order to make camera easier to be operated (camera does not need a button or switch for operating camera in recording mode).

Allowable Subject Matter

8. Claims 1-3 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1-3, see Examiner's statement of reasons for the indication of allowable subject matter as indicated in paper mailed on 3/22/2005.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NGOCYEN VU can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN *LN*
12/09/05


NGOCYEN VU
PRIMARY EXAMINER